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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/534,848	05/13/2005	Arnaud Metayer	825-02-630	8918

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EXAMINER

NEWAY, BLAINE GIRMA

ART UNIT	PAPER NUMBER
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3728

MAIL DATE	DELIVERY MODE
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04/14/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/534,848	Applicant(s) METAYER ET AL.	
	Examiner BLAINE G. NEWAY	Art Unit 3728	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 July 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 3-5,7,8,10-13,18,21 and 22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 3-5,7,8,10-13,18,21 and 22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 July 2008 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This office acknowledges the applicant's amendment filed 7/16/08. Claims 3-5, 7-8, 10-13, 15, 18 and 21-22 are pending in the application; and claims 1-2, 6, 9, 14, 16-17, and 19-20 have been canceled.

Claim Objections

2. The claims are generally narrative and indefinite, failing to conform with current U.S. practice. They appear to be a literal translation into English from a foreign document and are replete with grammatical and idiomatic errors.

The limitations "the axis (X2)", "the first end (14)", "the second end (18)", "the axis (X1)", "means (19)", "the wall (116)" are recited through out the claims. Reference numerals within parentheses cannot be used as a substitute for clear recitation of structure.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 3-5, 7-8, 10-13, 15, 18 and 21-22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 21, recites the limitation "a closed lower end (18) formed by said base (118) of the lower end (18)" it is unclear how an end could be formed by a base of the same end. It is unclear what structural limitation is being claimed.

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Regarding claim 10, the orientation of “longitudinal axis (X1)” and “longitudinal axis (X2)” is not stated in the claim, making the claim indefinite.

Regarding claims 21 and 22, the Examiner notes that the use of the term “suspension means” is confusing since it appears to invoke 35 U.S.C. 112, sixth paragraph but is not written in the proper format, rendering the claims indefinite.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

7. Claims 3-5, 7-8, 10-13, 5, 18 and 21-22 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over Jackson (US 3,191,791) in view of Stahl (US 5,344,022).

Regarding claim 21, Jackson discloses a storage element or tray 11 having a plurality of housings 19 capable of retaining a plurality of appropriately sized brake

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discs. Jackson further discloses the storage element having a rectangular shape with a base separated from a first upper end by a first wall; the first upper end surrounding an opening and having a rim 16 thereon defining a bearing surface to receive a second base of another storage element 12. Jackson also discloses each of the plurality of housings 19 having a cylindrical body with an imaginary longitudinal axis; a second upper end having an opening therein and a closed lower end formed by the base of the storage element; the second upper end being separated from the closed lower end by a second wall; each of the plurality of housings having an internal diameter greater than an external diameter of an appropriately sized brake disc; the second wall having at least one suspension means capable of engaging a radially external end of a track on a first or second face of an appropriately sized brake disc so that a non-zero distance separates the first or second face of the appropriately sized brake disc facing towards the closed lower end of the housing on placing the appropriately sized brake disc in the housing (figure 1 and marked up figure 3) .

Jackson fails to disclose the rim 16 projecting from the upper end at right angles to a vertical plane of the first wall and extending toward the inside of the storage element; a reinforcing surface extending from the rim back into the first wall to add strength to the rim and support for base of the other storage element 12.

However, Stahl teaches a container having a rim 44 projecting from an upper end at right angle to a vertical plane of a side wall and extending toward the inside of the container; and a reinforcing surface extending from the rim back into the side wall to define a stacking post (figure 1).

Therefore, it would have been obvious to one of ordinary skill in the art to substitute a rim as, for example, taught by the Stahl reference for the rim 16 of the Jackson device wherein so doing would amount to mere substitution of one functionally equivalent stacking mechanism for another within the same art and the selection of any of these stacking mechanisms would work equally well in the Jackson device.

Regarding claim 22, Jackson further discloses the cylindrical body of each of the plurality of housings being defined by a larger-diameter first cylindrical portion having a diameter greater than a diameter of an appropriately sized brake disc and a smaller-diameter second cylindrical portion; the first cylindrical portion being separated from the second cylindrical portion by at least one shoulder that defines the suspension means (figure 1 and marked up figure 3).

Regarding claim 3, Jackson further discloses the at least one shoulder is made of at least two parts arranged in the same plane and formed by angular sectors distributed, advantageously uniformly, over the periphery of the housing (figure 1 and marked up figure 3) .

Regarding claim 4, Jackson further discloses several shoulders arranged in parallel planes so that the storage element is capable of taking brake discs of different diameters (figure 1 and marked up figure 3).

Regarding claim 5, Jackson further discloses each shoulder connecting a larger-diameter part to a smaller-diameter part, and the smaller-diameter part forming the next larger-diameter part, and in that each larger-diameter part has an axial dimension along

the longitudinal axis capable of being at least equal to half the distance separating first and second faces of an appropriately sized brake disc (see marked up figure 3).

Regarding claims 7 and 8, Jackson discloses the all elements of the claimed invention except for the width of the shoulder being preferably between 4 mm and 10 mm or more preferably being between 6 mm and 8 mm. It would have been obvious to one having ordinary skill in the art at the time the invention was made to make the width of the shoulder between 6 mm and 8 mm, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233.

Regarding claim 10, Jackson further discloses the housing having a dimension along the imaginary longitudinal axis at least equal to the dimension of an appropriately sized brake disc along its longitudinal axis (marked up figure 3).

Regarding claim 11, Jackson discloses the storage element being fabricated of expandable polystyrene. The examiner notes that claim 11 is product-by-process claim. "Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on the method of its production. If the product in the product-by-process claim is the same as or obvious from the product of the prior art, the claim is unpatentable even though the prior product was made by a different process." *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985).

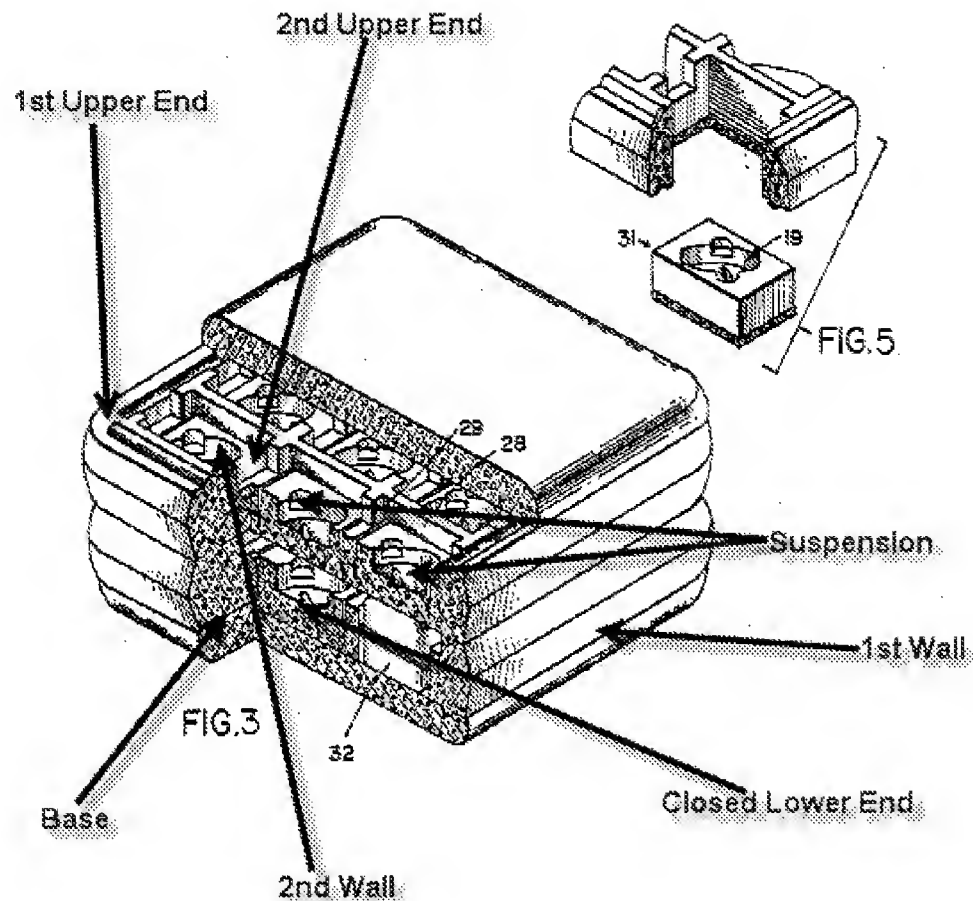
Regarding claims 12 and 13, Jackson does not appear to disclose the storage element being made of ABS or polyethylene. Official notice is taken that it is old and

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conventional to make containers form ABS or polyethylene. Therefore, It would have been obvious to one having ordinary skill in the art at the time the invention was made to have constructed the storage element of Jackson, of ABS or polyethylene, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

Regarding claim 15, Jackson further discloses the storage element having twelve housings distributed uniformly and having a shape of a rectangular parallelepiped (figure 4).

Regarding claim 18, Jackson further discloses a means defined by a plurality of blocks 28 centrally located between several housings, advantageously between four housings capable of assisting the bearing surface in supporting the base of the other storage element (figure 3).



Response to Arguments

8. Applicant's arguments with respect to claims 3-5, 7-8, 10-13, 5, and 18 have been considered but are moot in view of the new grounds of rejection.

Conclusion

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

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§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to BLAINE G. NEWAY whose telephone number is (571)270-5275. The examiner can normally be reached on M-F 7:30 AM- 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on 571 272-4562. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/JILA M MOHANDESI/
Primary Examiner, Art Unit 3728

BGN
4/8/2009